

REMARKS

In the outstanding Office Action, the Examiner took the following actions:

(a) rejected claims 1-6, 8, 11, and 33 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,666,438 to Beernink et al. ("Beernink '438");

(b) rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Beernink '438 in view of U.S. Patent Application Publication No. 2001/0026639 to Sparr et al. ("Sparr");

(c) rejected claims 9, 10, 12-16, 18-24, 26-32, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Beernink '438 in view of U.S. Patent No. 5,682,439 to Beernink et al. ("Beernink '439");

(d) rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Beernink '438 in view of Beernink '439 and U.S. Patent No. 5,970,170 to Kadashevich et al. ("Kadashevich"); and

(e) rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Beernink '438 in view of Beernink '439 and Sparr.

By this reply, no amendments have been made. Claims 1-34 remain pending in this application.

I. Rejection of claims 1-6, 8, 11, and 33 under 35 U.S.C. § 102(b) as allegedly being anticipated by Beernink '438

Applicant respectfully traverses the rejection of claims 1-6, 8, 11, and 33 as being anticipated by Beernink '438. Beernink '438 fails to teach, or even suggest, each and every feature recited in those claims.

Independent claim 1 recites, for example,

comparing the handwritten pattern to a plurality of templates . . . [and] returning a best template . . . that represents one of the plurality of writing symbol patterns as a best writing symbol pattern which . . . is most similar to the handwritten pattern, wherein at least two of the plurality of templates comprise different ones of the plurality of writing symbol patterns which represent different ways of writing a single symbol.

Beernink '438 fails to teach at least these elements. Beernink '438 discloses,

text, graphical, and other data can then be entered into this second note area 54b. For example, the text object T is a phrase that has been entered into second note area 54b. In the described embodiment, text object T was originally entered as several strokes of handwritten "ink" which were recognized by the CPU and converted into printed words of the object T. Beernink '438, column 5, lines 63-67.

The present invention makes use of a recognizer implemented by CPU 12 to recognize ink strokes input by a user with stylus 38. The recognizer analyzes the entered ink and attempts to match the ink to a letter, word, shape, or other symbol present in a database accessible to the recognizer. Id. at column 7, lines 19-23.

Beernink '438 does not, for example, describe the letter, word, shape, or other symbol, matched to the ink strokes input by the user, and thus, Beernink '438 cannot teach that at least two of the letter, word, shape, or other symbol "comprise different ones of a plurality of writing symbol patterns, which represent different ways of writing a single symbol," as recited in independent claim 1.

Beernink '438 discloses that a user can navigate from note area 54b to preference screens 69, shown in FIGS. 6a, 6b, 7, and 8, which may include a letter styles screen 76. See Beernink '438, column 7, lines 66 and 67; and column 8, lines 1 and 2. Letter styles screen 76 relates to a learning phase of the system in Beernink '438, and is used to capture data that is later used by the recognizer. See Id. at column 2, lines 42-47; and column 10, lines 13-16. While Beernink '438 discloses different letter styles in letter style screen 76, Beernink '438 does not teach that the ink strokes input by a user are compared to the letter styles. Rather, Beernink '438 discloses:

[r]eferring now to FIG. 8 A user selects one of the characters 89 of which he wishes to modify the letter style CPU 12 then displays style

letters 95 for the selected character 89. For each displayed style letter 95, the user can select whether he or she writes that letter style either "sometimes" or "rarely" by actuating one of toggles 97 In the described embodiment, the shape of style letters 95 is presented in letter style screen 76, as well as the order of inputting the ink strokes which comprise the style letters The CPU preferably displays a real-time animation of the selected style letter being drawn Computer system 10 automatically saves adaptive learning data associated with the style letters selected and modified by the user. Beernink '438, column 10, lines 8-31 and 42-44.

Since Beernink '438 does not describe the letter, word, shape, or other symbol, matched to the ink strokes input by the user, and Beernink '438 does not teach that the ink strokes input by the user are compared to characters 89 or style letters 95 in letter style screen 76, Beernink '438 fails to teach or suggest "comparing the handwritten pattern to a plurality of templates . . . wherein at least two of the plurality of templates comprise different ones of the plurality of writing symbol patterns which represent different ways of writing a single symbol," as recited in independent claim 1. For at least this reason, Beernink '438 fails to anticipate independent claim 1. Applicant respectfully requests reconsideration of the rejection of independent claim 1, and the timely allowance of independent claim 1.

Also, Beernink '438 does not teach returning one of characters 89 or style letters 95 that is most similar to the ink strokes input by the user. Rather, Beernink '438 discloses that "[a] user selects one of the characters 89 CPU 12 then displays style letters 95 for the selected character 89." Beernink '438, column 10, lines 13-19. Since Beernink '438 does not teach returning one of characters 89 or style letters 95 that is most similar to the ink strokes input by the user, Beernink '438 fails to teach or suggest "returning a best template selected from the plurality of templates that

represents one of the plurality of writing symbol patterns as a best writing symbol pattern which . . . is most similar to the handwritten pattern,” as recited in independent claim 1. For at least this reason, Beernink '438 fails to anticipate independent claim 1. Applicant respectfully requests reconsideration of the rejection of independent claim 1, and the timely allowance of independent claim 1.

Applicant also respectfully requests clarification as to the Examiner's interpretation of style letters 95 of Beernink '438. On page 2 of the Office Action, the Examiner states, “a handwritten pattern (“ink strokes input” at 7:19-21; e.g., fig. 8, item 95),” indicating that style letters 95 of Beernink '438 correspond to a handwritten pattern. Yet on page 3 of the Office Action, the Examiner states, “wherein each of the plurality of templates (e.g., template “f” in fig. 8) represents at least one of a plurality of writing symbol patterns (e.g., template “f” comprises four writing symbol patterns including items 95, 95b),” indicating that style letters 95 of Beernink '438 correspond to a plurality of writing symbol patterns. However, the claimed “handwritten pattern” and “plurality of writing symbol patterns” are separate elements of independent claim 1, and thus, it is improper for the Examiner to apply a single element, style letters 95, against those separate elements. For at least this additional reason, Applicant respectfully requests reconsideration of the rejection of independent claim 1, and the timely allowance of independent claim 1.

Claims 2-6, 8, and 11 each depend from independent claim 1, and are allowable for at least the reasons stated above with respect to claim 1. In addition, each of the dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

Independent claim 33, while of different scope, recites elements similar to those recited in independent claim 1. For example, independent claim 33 calls for a combination including, for example, “means for recognizing the detected handwritten pattern and returning one of the plurality of patterns of a best template of the handwritten pattern, said best template being most similar to the handwritten pattern.” Thus, Beernink '438 fails to teach each and every feature recited in independent claim 33. Accordingly, independent claim 33 is allowable at least for reasons similar to those discussed above with respect to independent claim 1. Applicant respectfully requests the timely allowance of independent claim 33.

II. Rejection of claim 7 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beernink '438 in view of Sparr

Applicant respectfully traverses the rejection of claim 7 as being unpatentable over Beernink '438 in view of Sparr. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the

claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claim 7 depends from independent claim 1, and thus includes all the elements thereof. As set forth above, Beernink '438 fails to teach or suggest at least “comparing the handwritten pattern to a plurality of templates . . . returning a best template . . . that represents one of the plurality of writing symbol patterns as a best writing symbol pattern which . . . is most similar to the handwritten pattern, wherein at least two of the plurality of templates comprise different ones of the plurality of writing symbol patterns which represent different ways of writing a single symbol,” as recited in independent claim 1, and required by claim 7. Sparr fails to cure the deficiencies of Beernink '438.

That is, Sparr also fails to teach or suggest at least “comparing the handwritten pattern to a plurality of templates . . . returning a best template . . . that represents one of the plurality of writing symbol patterns as a best writing symbol pattern which . . . is most similar to the handwritten pattern, wherein at least two of the plurality of templates comprise different ones of the plurality of writing symbol patterns which represent different ways of writing a single symbol.”

In view of the mischaracterization of Beernink '438 discussed above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the combination of claim 7. Thus, the Examiner has failed to clearly articulate a reason why claim 7 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 7, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

III. Rejection of claims 9, 10, 12-16, 18-24, 26-32, and 34 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beernink '438 in view of Beernink '439

Applicant respectfully traverses the rejection of claims 9, 10, 12-16, 18-24, 26-32, and 34 as being unpatentable over Beernink '438 in view of Beernink '439. A *prima facie* case of obviousness has not been established.

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1, from which claims 9, 10, and 12-14 depend, calls for a combination including, for example,

comparing the handwritten pattern to a plurality of templates . . . returning a best template . . . that represents one of the plurality of writing symbol patterns as a best writing symbol pattern which . . . is most similar to the handwritten pattern, wherein at least two of the plurality of templates comprise different ones of the plurality of writing symbol patterns which represent different ways of writing a single symbol.

The Examiner alleges that characters 89 of Beernink '438 correspond to the claimed "plurality of templates," and that style letters 95 correspond to the claimed "plurality of writing symbol patterns." See Office Action, page 3. This is not correct.

Beernink '438 discloses,

[r]eferring now to FIG. 8 A user selects one of the characters 89 of which he wishes to modify the letter style CPU 12 then displays style letters 95 for the selected character 89. For each displayed style letter 95, the user can select whether he or she writes that letter style either "sometimes" or "rarely" by actuating one of toggles 97 In the described embodiment, the shape of style letters 95 is presented in letter style screen 76, as well as the order of inputting the ink strokes which comprise the style letters. Beernink '438, column 10, lines 8-28.

However, Beernink '438 does not teach or suggest that the ink strokes input by a user are compared to characters 89. Thus, characters 89 in letter style screen 76 cannot correspond to the claimed "plurality of templates," since independent claim 1 recites the step of "comparing the handwritten pattern to a plurality of templates." In view of the mischaracterization of Beernink '438, above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of independent claim 1. Thus, the Examiner has failed to clearly articulate a reason why claims 9, 10, and 12-14, which depend from independent claim 1, would have been obvious to one of ordinary skill in

the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claims 9, 10, and 12-14, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

Independent claims 15 and 34, while of different scope, recite elements similar to those recited in independent claim 1, and Beernink '439 fails to cure the deficiencies of Beernink '438. Thus, independent claims 15 and 34 are allowable over Beernink '438 and Beernink '439, at least for reasons similar to those discussed above with respect to independent claim 1. Claims 16, 18-24, and 26-32 depend from independent claim 15, and thus, are allowable for at least the same reasons that independent claim 15 is allowable. In addition, these dependent claims recite unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

IV. Rejection of claim 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beernink '438 in view of Beernink '439 and Kadashevich

Applicant respectfully traverses the rejection of claim 17 as being unpatentable over Beernink '438 in view of Beernink '439 and Kadashevich. A *prima facie* case of obviousness has not been established. Claim 17 depends from claim 15, and thus includes all the elements thereof. As set forth above, Beernink '438 fails to teach or suggest at least “comparing the handwritten pattern to a plurality of templates . . . returning a best interpretation of the handwritten pattern, said best interpretation being based on one of the plurality of writing symbol patterns as a best writing symbol pattern . . . that . . . is most similar to the handwritten pattern, wherein at least two of the plurality of templates comprise different one of the plurality of writing symbol patterns

which represent different ways of writing a single symbol.” Beernink ‘439 and Kadashevich fail to cure the deficiencies of Beernink ‘438. That is, Beernink ‘439 and Kadashevich also fail to teach or suggest at least “comparing the handwritten pattern to a plurality of templates . . . returning a best interpretation of the handwritten pattern, said best interpretation being based on one of the plurality of writing symbol patterns as a best writing symbol pattern . . . that . . . is most similar to the handwritten pattern, wherein at least two of the plurality of templates comprise different one of the plurality of writing symbol patterns which represent different ways of writing a single symbol,” as recited in independent claim 15 from which claim 17 depends.

In view of the mischaracterization of Beernink ‘438 discussed above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the combination of claim 17. Thus, the Examiner has failed to clearly articulate a reason why claim 17 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 17, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

V. Rejection of claim 25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beernink ‘438 in view of Beernink 439 and Sparr

Applicant respectfully traverses the rejection of claim 25 as being unpatentable over Beernink ‘438 in view of Beernink ‘439 and Sparr. A *prima facie* case of obviousness has not been established. Claim 25 depends from independent claim 15, and thus includes all the elements thereof. As set forth above, Beernink ‘438 fails to teach or suggest at least “comparing the handwritten pattern to a plurality of templates .

. . . returning a best interpretation of the handwritten pattern, said best interpretation being based on one of the plurality of writing symbol patterns as a best writing symbol pattern . . . that . . . is most similar to the handwritten pattern, wherein at least two of the plurality of templates comprise different one of the plurality of writing symbol patterns which represent different ways of writing a single symbol.” Beernink ‘439 and Sparr fail to cure the deficiencies of Beernink ‘438. That is, Beernink ‘439 and Sparr also fail to teach or suggest at least “comparing the handwritten pattern to a plurality of templates . . . returning a best interpretation of the handwritten pattern, said best interpretation being based on one of the plurality of writing symbol patterns as a best writing symbol pattern . . . that . . . is most similar to the handwritten pattern, wherein at least two of the plurality of templates comprise different one of the plurality of writing symbol patterns which represent different ways of writing a single symbol,” as recited in independent claim 15 from which claim 25 depends.

In view of the mischaracterization of Beernink ‘438 discussed above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the combination of claim 25. Thus, the Examiner has failed to clearly articulate a reason why claim 25 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 25, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

In view of the foregoing remarks, Applicant respectfully requests reconsideration of the pending rejections in this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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